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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 03/13/2008				
Gail H. Zarick IBM CORPORATION Intellectual Property Law Dept. P.O. Box 218 Yorktown Heights, NY 10598			EXAMINER KESACK, DANIEL	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 03/13/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/821,445

Applicant(s)

DAN ET AL.

Examiner

Daniel Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendments and remarks filed November 26, 2007. Applicant's arguments have been fully considered. Claims 1 and 3-34 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-20, and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Donahue, U.S. Patent No. 7,024,397.

Claims 1, 8, 12, 15, 16, 28, 30, 31, 33, 34, Donahue discloses a method and apparatus for negotiating a contract using a computer network, comprising:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to contract

negotiation, and communicating a request to negotiate (column 4 lines 5-15 and column 8 lines 3-29), wherein the negotiation protocol is the structured process (figure 2), and wherein the agreement is inherent when the parties register with the system and begin to partake in the negotiation;

conducting a pre-negotiation between the plurality of parties to form a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least on party in at least on electronic document, prior to the negotiation, wherein the negotiation meta contract is public defined for all parties, prior to negotiation (figure 13 and column 11 line 59 – column 12 line 17);

conducting an automatic negotiation, according to the negotiation meta contract, between the one or more applications of each of the plurality of parties (figure 15, and column 15 lines 31-52).

Claims 3, 22, Donahue teaches performing at least on sub-negotiation (column 8 lines 43-58).

Claim 4, Donahue teaches forming an electronic commerce contract (column 15 lines 52-57).

Claims 5, 23 Donahue teaches the parties are users on the Internet using applications (column 3 lines 40-65). The users inherently operate through service

providers, and both users' systems act as clients and servers throughout the negotiation processes.

Claims 6, 18, 19, Donahue teaches human intervention during the negotiation (column 12 lines 41-52 and column 13 line 66 – column 14 line 7). While Donahue does not explicitly teach the "suspend-negotiation action" taking place, the negotiation process can not be completed until the issue requiring human intervention is settled (column 5 lines 16-20), and therefore, if human intervention is needed, the negotiations are inherently suspended.

Claim 7, Donahue teaches each party maintains the contract state of the overall negotiation (column 11 lines 18-36).

Claims 9, 13, Donahue teaches the starting state is selectable from a set of profiles in a repository by at least one of the parties prior to negotiation (figure 1B, #126, 127).

Claim 10, Donahue teaches the publicly defined template is a landlord-tenant lease, or a real-estate purchase agreement (abstract).

Claim 11, Donahue teaches the repository is a public registry within the negotiation service broker's system (figure 1A, #100).

Claim 14, Donahue teaches the server maintains negotiation logic for processing the negotiation request that is customized to the contract template (figure 1A, #104).

Claims 17, 32, Donahue teaches deferring, which is essentially a rejection of the current state of the negotiation (column 9 lines 13-36).

Claim 20, Donahue teaches specifying a suspension time interval in which human intervention is enabled (column 13 lines 46-52).

Claim 24, Donahue teaches a graphical user interface (figure 13).

Claims 25-27, Donahue teaches the meta contract contains a complete set of rules for determining the validity of a meta contract operation, and wherein verifying agreements to contract proposals is considered a business specific method (column 4 lines 16-28).

Claim 29, Donahue teaches at least one of the parties delegates at least part of the negotiation process to a broker (column 8 lines 3-12, and column 12 lines 41-52).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue.

Donahue does not teach the server waits until the suspension time interval expires before it takes further action. It would be an obvious next step to one of ordinary skill in the art that if the completed negotiation requires agreement on all pending issues, and a pending issue has been selected for human intervention, it would be desirable, as well as necessary, that the system waits until the invention yields a negotiated result before continuing with negotiations. If the system requires agreement on all points, waiting for the completion of a human negotiation before continuing

negotiations yields the predictable result of having a fully negotiated contract, with no disagreements.

Response to Arguments

7. Applicant's arguments filed November 26, 2007 have been fully considered but they are not persuasive.

While the amendment filed November 26, 2007 included new limitations, Examiner will address Applicant's arguments since the cited portions of the prior art of record have not changed. Examiner considers the initial stage of the Donahue process, where the parties review the issues and choose whether there is an agreement, or whether further negotiation is necessary to be the Applicant's claimed pre-negotiation of a meta contract. Applicant argues the meta contract defines a contract starting state (11/26/2007 arguments, page 10), which is exactly what the initial phase of Donahue accomplishes. This phase results in a starting state on negotiations, and controls the ensuing negotiation process because it identifies which issues are not agreed upon, and therefore which issues need to be negotiated. Furthermore, Examiner submits that this meta contract is in the form of an electronic document because the choices are being submitted via a web browser, and web browsers operate via html electronic documents.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
March 1, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691